UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,591	08/16/2006	Pann-Ghill Suh	20010-21USA	3560

35736 7590 10/28/2008

JHK LAW
P.O. BOX 1078
LA CANADA, CA 91012-1078

EXAMINER	
MOHAMED, ABDEL A	

ART UNIT	PAPER NUMBER
1654	

MAIL DATE	DELIVERY MODE
10/28/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/597,591	SUH ET AL.	
	Examiner	Art Unit	
	ABDEL A. MOHAMED	1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 August 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-20* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

ELECTION/RESTRICTION

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-13 and 20, drawn to a polypeptide comprising a W-rich peptide and a conservative variant or functional fragment thereof or a W-rich mimic thereof, a method of preventing inflammation in a subject comprising the steps of providing an inflammation preventing effective amount of the polypeptide according to claim 1 or a W-rich peptide mimic thereof to the subject in need thereof and a pharmaceutical composition comprising the polypeptide according to claim 1 or W-rich mimic thereof.

Group II, claims(s) 14, drawn to a method of treating arthritis in a subject comprising the steps of providing an inflammation preventing effective amount of the polypeptide according to claim 1 or a W-rich peptide mimic thereof to the subject in need thereof.

Group III, claim(s) 15, drawn to a method of treating an auto-immune disease in a subject comprising the steps of providing a therapeutically effective amount of the polypeptide according to claim 1 or a W-rich peptide mimic thereof to the subject in need thereof.

Group IV, claim(s) 16, drawn to method of preventing binding of Aβ42 to human neutrophils comprising contacting the neutrophil with the polypeptide according to claim 1 or a W-rich peptide mimic thereof.

Group V, claim(s) 17, drawn to a method of treating Alzheimer's disease comprising administering a therapeutically effective amount of the polypeptide according to claim 1 or a W-rich peptide mimic thereof to the subject in need thereof.

Group VI, claim(s) 18 and 19, drawn to a method of identifying a FPR class receptor antagonist wherein the FPR class receptor is a FPRL1 comprising the steps of providing a cell having a FPR class receptor; contacting the cell with a candidate antagonist compound; and identifying the candidate antagonist compound as an antagonist compound if the candidate binds to a FPR class receptor and inhibits its activity.

The inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the methods of Groups I-VI do not correspond to the same technical features and are not connected in design, operation or effect because they differ in method steps, parameters and reagents used, although, the five groups use the same compounds as recited above, and as such, the method of Group I is directed to a method of preventing inflammation in a subject comprising the steps of providing an inflammation preventing effective amount of the polypeptide according to claim 1 or a W-rich peptide mimic thereof to the

subject in need thereof. Group II is directed to a method of treating arthritis in a subject comprising the steps of providing an inflammation preventing effective amount of the polypeptide according to claim 1 or a W-rich peptide mimic thereof to the subject in need thereof. Group III is directed to a method of treating an auto-immune disease in a subject comprising the steps of providing a therapeutically effective amount of the polypeptide according to claim 1 or a W-rich peptide mimic thereof to the subject in need thereof. Group IV is directed to a method of preventing binding of Aβ42 to human neutrophils comprising contacting the neutrophil with the polypeptide according to claim 1 or a W-rich peptide mimic thereof. Group IV is directed to a method of treating Alzheimer's disease comprising administering a therapeutically effective amount of the polypeptide according to claim 1 or a W-rich peptide mimic thereof to the subject in need thereof.

With respect to Group VI, this group differs from Groups I-V in using different compounds for different purposes. Group VI is directed to an assay method of identifying a FPR class receptor antagonist while Groups I-V are directed to various methods of treatment and prevention of different diseases and/or conditions using basically the same compounds for different purposes. Thus, Groups I-V are methods of treatment or prevention while Group VI is an assay method. Therefore, the methods of Groups I-VI as recited above do not correspond to the same technical features and are not connected in design, operations or effects because they differ in method steps, parameters and reagents used and functions, and as such, the methods as grouped are independent and distinct, each from the other because they represent different technical

features and different inventive endeavors. Thus, the Groups require different patent and literature search and as such Groups I-VI do not share the same technical features, the inventions do not relate to the same inventive concept.

SEQUENCE ELECTION REQUIREMENT

The various sequences disclosed in Groups I-V of claims 6-11 encompass peptides having different structures which are patentably distinct and/or independent, one from the other, and capable of independent use. Further, there is no sequence linking each with other, it is only consensus.

Therefore, the sequences are patentably distinct because they are unrelated sequences and each unrelated sequence is considered a separate and distinct product. For an elected invention drawn to either amino acid or polypeptide sequences, the Applicant must elect a **single** peptide sequence (See MPEP 803.04). Due to the increasing large size of sequence databases which must be searched and the increasing numbers of applications requiring sequence searches, it creates an undue burden on the Office to search more than a single sequence (product) per application. For these reasons, the requirement of 37 CFR 1.141 *et seq.* is no longer waived and Applicant is required to elect a **single** sequence for examination. Applicant is reminded that this is a **restriction requirement**, not an election of species as contended by Applicant. Thus, Applicant is required to elect a single disclosed sequence and/or provide a single subsequence within a disclosed sequence wherein the subsequence

for the elected is searched because the inventions do not relate to a single inventive concept.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

CONCLUSION AND FUTURE CORRESPONDANCE

Claims 1-20 are subject to restriction and/or election requirement.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ABDEL A. MOHAMED whose telephone number is (571)272-0955. The examiner can normally be reached on First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on (571) 272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mohamed/A. A. M./
Examiner, Art Unit 1654

/JON P WEBER/
Supervisory Patent Examiner, Art Unit 1657